

Remarks

Claims 1-26 are pending and at issue in the present application.

Applicants traverse the rejection of claims 1-26 under the doctrine of obviousness-type double patenting over Warmus et al. in view of one or more of VanderDrift and Mastie.

Enclosed with this response is a terminal disclaimer to obviate the rejection of claims 1-26 over Warmus et al. in view of one or more of VanderDrift and Mastie.

Applicants further traverse the rejection of claims 1-26 as anticipated by or obvious over Cohen et al.

Claim 1, and claims 2-15 dependent directly or indirectly thereon, recite a software system for generating a second page description file from a first page description file. The software system comprises a first routine for generating a template, a second routine for extracting data indicative of portions of the first page description file to generate a database for storing the extracted data and a third routine for generating a second page description file from the template and the database.

Claim 16, and claims 17-26 dependent directly or indirectly thereon, recite a method of generating a second page description file from a first page description file including the steps of generating a template, extracting data indicative of portions of the first page description file to generate a database for storing the extracted data and generating a second page description file from the template and the database.

Cohen et al. does not teach or suggest extracting data from a first page description file to generate a database for storing the extracted data and generating a second page description file from the database and a template as recited by the claims at issue.

In fact, Cohen et al. discloses a document generation and delivery system that stores a number of pre-defined overlays, where each overlay includes a plurality of data fields. A set of instructions is generated to define the location of each data field within the overlay. Input data, received in the form of character strings, identifies the overlay to be used and provides specific data for insertion into the defined data fields within the selected overlay in accordance with the associated set of instructions.

Because Cohen et al. does not disclose each of the steps recited by claims 1-26, it follows that such claims are not anticipated thereby. The claims at issue are also not obvious over Cohen et al. for the reasons stated below.

Applicants also traverse the rejection of claims 10 and 23 as unpatentable over Cohen et al. in view of Mastie.

Mastie does not supply the deficiencies noted with respect to Cohen et al. Mastie discloses a method and apparatus for assembling a set of input page files in the correct sequence to generate a single output file in the form of a digital book. There is no disclosure or suggestion that it would be desirable or even possible to extract data indicative of portions of a first page description file to generate a database and employ the database and a template in generating a second page description file. Therefore, the rejection of claims 10 and 23 should be withdrawn.

Furthermore, because neither Cohen et al. nor Mastie discloses or suggests that it would be desirable or even possible to extract data from a first page description file to generate a database for storing the extracted data and generate a second page description file from the database and a template, as specified by claims 1-26, it is evident that the claims are not obvious thereover. The prior art must disclose at least a suggestion of an incentive for the claimed combination of elements in order for a *prima facie* case of obviousness to be established. See *In re Sernaker*, 217 U.S.P.Q. 1 (Fed. Cir. 1983) and *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). Accordingly, the rejection of the claims at issue should be withdrawn.

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims at issue and reconsideration thereof are respectfully requested.

The Commissioner is hereby authorized to charge any fees which may be required in connection with this response from Deposit Account No. 50-1903. A copy of this paper is enclosed.

Respectfully submitted,

Law Offices of
McCracken and Frank

By:


Manisha C. Wulf
Reg. No. 41,665

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200 W. Adams
Suite 2150
Chicago, IL 60606
Telephone: (312) 263-4700
Facsimile: (312) 263-3990
Customer No.: 29471